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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/113,712	07/10/1998	EDWARD F. HELINSKI	EN997043	8352

7590

08/03/2004

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EXAMINER
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PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 08/03/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/113,712

**Applicant(s)**

HELINSKI, EDWARD F.

**Examiner**

Jason Prone

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-20,23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Prosecution is reopened in view of new grounds of rejection that have come to the attention of the examiner.

#### *Drawings*

1. The drawings are objected to because on the right side of Figure 2, above item "33", there is a reference line without a reference number. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first alignment mark" and the "second alignment mark", of claim 4 and 9, and the "compressible spring

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engaging the punch and the second housing", of claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: On page 13 line 4, "item 52". Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement

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sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The specification is objected to under 37 CFR 1.71, as being confusing and difficult to comprehend the invention and compare with prior art. For example, the following is not understood: It is unclear how the aperture of the upper die and the punch receiving passage of the lower die will ever be aligned. It is unclear how the upper and lower die receiving passages are configured to permit the rotation of the upper and lower dies. It is unclear how the upper and lower dies are rotated. It is unclear how the upper and lower housings rotate. It is unclear how the dies are marked and how the marks are used. It is unclear how the work piece is loaded. It is unclear if the dies are held in their respective housings. It is unclear how the dies remain in their rotated position. See the rejections under 35 USC § 112, first paragraph for more details.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. It is unclear how the aperture of the upper die and the punch receiving passage of the lower die will ever be aligned. The upper and lower dies rotate within the same sized bore, therefore both dies are spinning on the same axis. Using Figure 2 and assuming that the aperture "40" is centered, when the upper die rotates the aperture will just spin and not move from the center. The punch receiving passage is misaligned from the aperture and, therefore, will orbit around the aperture when the lower die is rotated. From Figure 2 and the specification, there is no way that the punch receiving passage and the aperture could ever be aligned.

8. It is unclear how the upper and lower die receiving passages are configured to permit the rotation of the upper and lower dies and it is unclear how the dies actually rotate. It is not understood what structure allows the apparatus to be configured to allow rotation. From Figure 2 and the specification, no structure has been disclosed that would enable the apparatus to allow rotation of the upper and lower dies. In light of this argument, it would then be apparent that any prior art, mainly the Kranik et al.

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Patent, is as configured for rotation as the apparatus from the instant application. Also, it is uncertain what structure rotates the upper and lower dies. It is understood that the upper and lower dies rotate in their respective housings but there must be a third structure to do the actual rotation.

9. It is unclear how the upper and lower housings rotate. It is uncertain what structure allows the housings to be rotatable and what structure actually rotates the housings.

10. It is unclear how the dies are marked and how the marks are used. It is understood that Figure 2 is a cross section. It is uncertain what structure creates the marks. Also, it is uncertain how the marks are to line up the dies. It is not certain if the marks are lined up by a detector/computer or if they are lined up by eye.

11. It is unclear if the dies are held in their respective housings and how the work piece is loaded. It is uncertain what structure keeps the dies in their respective receiving passage. When the dies rotate, what structure maintains the dies at the same position, thereby preventing any oscillatory motion. In light of the previous argument, it is uncertain how a work piece is loaded. It is unclear if the housings can move in a vertical direction towards and away from each other. If this is the case, do their respective dies travel with the housings?

12. In regards to claim 11, the phrase "compressible spring engaging the punch and the second housing" is unclear. There is no support in the specification or a Figure corresponding to this limitation. Therefore, it is unclear what structure is incorporated

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into the apparatus with the compression spring contacting the second housing instead of the first housing.

13. It is unclear how the dies remain in their rotated position. It is uncertain what structure acts as a stopper to stop the dies from rotating.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-11, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. In regards to claims 1 and 6, it is uncertain what structure allows the apparatus to be configured to allow for rotation of the dies. It is unclear how the first die aperture and the second die aperture will ever be aligned.

17. In regards to claims 4 and 9, it is unclear what structure creates the first and second alignment marks on the first and second dies and what structure uses the alignment marks to align the first and second dies.

18. In regards to claims 21 and 22, it is unclear how the upper and lower housings rotate. It is uncertain what structure allows the housings to be rotatable and what structure actually rotates the housings.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-3, 5-8, and 10 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by Borello.

Borello discloses the same invention including a first die including a first die aperture for receiving a punch (58), a second die including a second die aperture for receiving the punch (62), a first housing including a first die passage receiving a portion of the first die (14), a second housing including a second die passage receiving at least a portion of the second die (16) and capable of receiving a portion of the first die (Fig. 6), that the second die passage is configured to permit the second die to rotate therein (64) thereby permitting the first die and second die aperture to be aligned with each other (Fig. 6), that the first die and second die passage are capable of permitting the first die to rotate therein (Fig. 6), that the first die and second die apertures are alignable to be concentric within about 5 millionths of an inch (Fig. 6, assuming the alignment is exact, inherently would be within 5 millionths of an inch), a punch (48), and that the second die passage receives all of the second die (62) and is capable of receiving at least a portion of the first die (Fig. 6).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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22. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borello in view of Blais. Borello discloses the invention but fails to disclose a compression spring engaging the punch and the first housing. Blais teaches a compression spring (22) engaging the punch (33) and the first housing (14). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Borello with a spring, as taught by Blais, to provide additional force to assist the apparatus when retracting the punch from a work piece.

23. It is to be noted that claims 4, 9, 21, and 22 have not been rejected over prior art. They may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

### ***Response to Arguments***

24. Applicant's arguments with respect to claims 1-11, 21, and 22 have been considered but are moot in view of the new ground(s) of rejection. The dies disclosed by Borello are threaded and are rotated into the treaded die passage-receiving portion of the housing. Since these dies are screwed into place, these die passage-receiving portions are configured to allow for rotation of the dies.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Naito, Lux, Johnson et al., Fujita, and Henderson et al.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

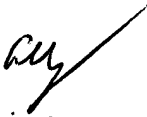
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

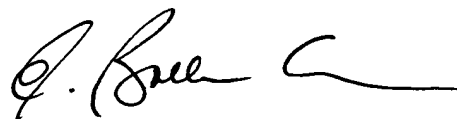
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP  
July 19, 2004



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